EG

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,228	06/01/2001	Jean Brossard	402078	3769

27717 7590 01/28/2004

SEYFARTH SHAW
55 EAST MONROE STREET
SUITE 4200
CHICAGO, IL 60603-5803

EXAMINER	
WHITE, CARMEN D	
ART UNIT	**PAPER NUMBER**
3714	8

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/872,228	BROSSARD, JEAN	
	Examiner	Art Unit	
	Carmen D. White	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 November 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-27,32-55,58 and 63-73* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6-27,32-55,58 and 63-73* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-8, 17-18, 54-55, 58 and 72-73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6-8 and 17-18 contain the trademark/trade name Elvis Presley™ (see previous office action, paper #5, which is incorporated herein by reference for further details/explanations).

Claims 54-55 and 58 recite the limitation "said plurality of graphics, images, motion pictures or other video clips" in line 14. There is insufficient antecedent basis for this limitation in the claim.

Claims 72 and 73 recite "the majority" in line 1 of each of the claims. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 19, 23, 32-33, 37-40, 45, 49-50 and 53 are rejected under 35 U.S.C. 102(e) as being anticipated by ***Walker*** et al (6,234,896).

Regarding claims 1-4, 19, 23, 32-33, 37-40, 45, 49-50 and 53, Walker teaches all the limitations of the claims as discussed in the previous office action, paper #5, which is incorporated herein by reference). Further regarding the newly added limitation of third outcome type which is a no win outcome type, Walker further teaches this feature {Fig. 7, "All others (losing combinations)"; col. 6, line 6 "(e.g., a losing gaming result or outcome)"}.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 6-18, 20, 34-36, 41-44, 46, 51-52 and 63-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Walker*** et al (6,234,896).

Regarding claims 9, 15, 44, 63, 66, 69, Walker teaches all the limitations of the claims as discussed above. While Walker teaches the selection of a video clip, Walker lacks teaching that the clips are picked at random. Walker is functionally capable of providing random video selection via the network server. This is merely a matter of software programming. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in Walker to make the results more unpredictable and thereby increase enthusiasm for playing the game.

Regarding claims 64, 67, 70, Walker teaches all the limitations of the claims as discussed above. Walker is silent regarding the feature of the selection of the audio/video clip by a moving member, which stops randomly on the clip. However, the examiner takes notice that it is well known in the art to provide a rotating dial that randomly points to a prize (e.g. Wheel of Fortune™). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in Walker as a means of selecting the prize clip to increase the player's enthusiasm for the outcome. This would increase player participation to the game by making it more exciting.

Regarding claims 10, 16, 35, 65, 68, 71,51, Walker teaches all the limitations of the claims as discussed above. Walker teaches the selection of an audio/video clip for the player via a server based on a player's identification parameters (col. 3,lines 33-36; col. 5,lines 59-64). However, Walker lacks teaching player selection of the clip. It would have been obvious to a person of ordinary skill in the art at the time of the invention to enhance Walker by including selection by the player of the video clip to give the player increased control over the gaming outcome. This would provide an added incentive for the player to play the game.

Regarding claims 6-8, 17-18, Walker teaches all the limitations of the claims as discussed above. Walker further teaches a video clip that is a music video or movie. These types of video clips are well known for having singing or acting celebrities. However, Walker does not teach the particular figure of Elvis Presley (this feature is indefinite- see above). However, it would have been obvious to a person of ordinary

skill in the art at the time of the invention to include any celebrity, such as Elvis, to motivate a fan to play the game. This would increase sales to the gaming establishment.

Regarding claims 11, 34, 36, 52, Walker teaches all the limitations of the claims as discussed above. Walker is silent regarding the explicit teaching of the feature of the video being associated with a bonus award. However, the examiner takes official notice that bonus awards are well known in the art. They provide increased incentive for players to continue wagering on a gaming machine. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to make the payout parameter a bonus outcome in Walker for the playing of the audio/video clip.

Regarding claims 12-14, 41-43, 46, Walker teaches all the limitations of the claims as discussed above. Walker is silent regarding the display of indicia, further highlighted indicia with differing levels of illumination. The examiner takes notice that it is well known to highlight indicia by illumination in slot machines. It would have been obvious to a person of ordinary skill in the art to include this feature in Walker to draw attention to the game display; thereby increasing player interest and promoting game play.

Regarding claim 20, Walker teaches all the limitations of the claim as discussed above. Walker further teaches a slot machine with simulated machine reels and a video display for indicating cards or other wagering game indicia (col. 2,lines 61-67). However, Walker is silent regarding physical [i.e. mechanical] slot reels. The examiner takes notice that this is well known in the art to have mechanical slots. This predates

video slots. It would have been obvious to a person of ordinary skill in the art to include mechanical reels in Walker to ensure game play can continue in the event of software/network problems. This would ensure that game sales do not diminish due to inoperability of the device.

Regarding claims 72 and 73, Walker teaches all the limitations of the claims as discussed above. Walker lacks the explicit disclosure of the majority of the outcomes being of the third type (i.e. losing). However, the examiner takes notice that it is well known in the slot gaming art for the majority of the outcomes to be non-winning (losing) outcomes. This prevents the gaming establishment from losing an extraordinary amount of money and thereby going out of business. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in Walker, for this reason.

Claims 21-22, 24-27, 47-48, 54-55, 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Walker*** et al (6,234,896) in view of ***Acres*** et al (5,752,882).

Regarding claims 21-22, 24-27, 47-48, 54-55, 58, Walker teaches all the limitations of the claim as discussed above. Walker lacks teaching the feature of a progressive prize jackpot. Acres teaches a progressive prize (abstract and Fig. 1). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the progressive prize of Acres in Walker to increase the player's winnings; thereby, making the player more motivated to continue playing the slot machine. Further, regarding the newly amended features of claim 54, Walker lacks the explicit teaching of the player selection of the video/graphic clips. However, the

examiner takes notice that it is well known in the art to allow the players to select particular parameters, such as the game played from a plurality of video clip games, in the video gaming art. This gives the players more control over their gaming experience; thereby creating more excitement and increased participation in the video game. Therefore, for these reasons, it would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in the video game of Walker.

Examiner's Response to Applicant's Remarks

Applicant argues that "Elvis Presley" is not a trademark. However, the examiner disagrees with Applicant. Applicant has not shown any evidence/proof that Applicant is has permission from Elvis Presley's estate to use such terminology in the instant claimed invention. Applicant argues that there is no possibility of misidentification of "Elvis Presley". The examiner asserts that this is Applicant's opinion and disagrees with this assertion by Applicant. Therefore the 112 2nd paragraph rejection remains where the terminology "Elvis Presley" is used in the instant claims.

Applicant states that claim 1 (and similarly claims 32 and 49) "calls for a third outcome type which is a no win (i.e. losing) outcome (***in which neither a monetary prize or an audiovisual display of the first and second winning outcomes is provided***)". However, the italicized and bold portion of Applicant's arguments are not present in the claims. Applicant's claims merely recite a third outcome type that is a no win outcome type. The instant amended claims do not recite language that describes any type of output for the third outcome type. Therefore, the examiner asserts that this instant claimed feature, as currently written, is taught by Walker et al (see above).

Further, Applicant argues that Walker does not teach the random selection of a video clip. The examiner acknowledged that this feature was not explicitly taught by Walker et al. However, The examiner addressed the obviousness of the incorporation of this feature in the previous office action, paper #5, which is incorporated herein by reference.

Applicant argues that the newly added features of instant claims 54-55 and 58 are not taught by the prior art. The examiner has addressed these features above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

USPTO Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.

cdw

MARK SAGER
PRIMARY EXAMINER